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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/420,002	10/18/1999	MARC A. COHEN		2196

22208 7590 11/04/2004

ROBERTS ABOKHAIR & MARDULA
SUITE 1000
11800 SUNRISE VALLEY DRIVE
RESTON, VA 20191

EXAMINER

HOOSAIN, ALLAN

ART UNIT PAPER NUMBER

2645

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/420,002

Applicant(s)

COHEN ET AL.

Examiner

Allan Hoosain

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 13-23,25-26,28-29,31,33,35,37,39,41,43 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dedrick** (US 5,717,923) in view of **de Hond** (US 5,737,533).

As to Claims 13,23, with respect to Figures 3-7, **Dedrick** teaches a method of direct advertising over a WAN (the Internet), comprising:

applying a clearing house database (first database) of information at a publisher 18 (web site) (Figure 4, label 70, Figure 1, label 20 and Col. 15, lines 24-27);

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applying a metering database (second database) having a multiplicity of attributes which are unique to a given individual (Figure 3, label 30, Figure 1, label 14 and Col. 15, lines 37-40),

applying a yellow page database (third database) of a plurality of advertising messages that are transmittable over the WAN (internet) (Figure 5, label 70, Figure 1, label 22 and Col. 16, lines 7-22),

linking the first, second and third databases to the publisher (web site) (Figure 1), receiving a visit to the publisher (web site) over the WAN (Internet) from an individual (Col. 14, lines 43-64),

determining the identity of the individual in the second database (Col. 9, lines 44-57), culling attributes for the individual from the second database based on their identity (Col. 10, lines 6-12),

selecting an advertisement (a message) based on the culled attributes (Col. 14, lines 58-60),

transmitting the selected message to the consumer over the WAN (Internet) (Col. 14, lines 58-60), and

transferring the information to the consumer over the WAN (Internet) (Col. 14, lines 58-60 and Col. 4, lines 21-23);

Dedrick does not teach the following limitations:

“Internet” and “web site”

de Hond teaches web sites using hyper text markup language documents over the Internet (Col. 2, lines 38-62). Having the cited art at the time the invention was made, it would

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have been obvious to one of ordinary skill in the art to add Internet and web cite capability to **Dedrick's** inventions for processing information in hypertext markup language as taught by **de Hond's** invention in order to provide linkage to documents on the same or other computer systems.

As to Claims 14-15, 18-19, 21-22, 25, 28, **Dedrick** teaches a method of directed advertising over the internet as claimed in claim 13 further comprising:

(i) selecting an additional advertising message based on the culled attributes (Col. 14, lines 55-64),

(ii) transmitting the additional advertising message to the consumer over the WAN (Internet),

(iii) transferring additional information to the consumer over the WAN (Internet),
and

(iv) repeating steps (i)-(iii) (Col. 14, lines 58-62);

Dedrick does not teach the following limitation:

"Internet"

de Hond teaches web sites using hyper text markup language documents over the Internet (Col. 2, lines 38-62). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add Internet and web cite capability to **Dedrick's** inventions for processing information in hypertext markup language as taught by **de Hond's** invention in order to provide linkage to documents on the same or other computer systems.

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As to Claims 16-17,20,26,29,31,33,35,37,39,41,43 with respect to Figures 3-7, **Dedrick** teaches a method of making offers over the Internet, comprising:

creating a first database of information at a publisher (web site) (Figure 4, label 70, Figure 1, label 20 and Col. 15, lines 24-27),

creating a second database of demographic information having a multiplicity of attributes for each of a plurality of individuals, each individually having an identity (Figure 3, label 30, Figure 1, label 14 and Col. 15, lines 37-40),

creating a third database of a plurality of advertising messages that are transmittable over the Internet (Figure 5, label 70, Figure 1, label 22 and Col. 16, lines 7-22),

the third database further including a vendor link for contacting over the internet a vendor sponsoring the advertising message (Col. 14, lines 55-64),

linking the first, second and third databases to the publisher (web site) (Figure 1), receiving a visit to the web site over the Internet from an individual (Col. 14, lines 55-64),

determining the identity of the individual in the second database (Col. 9, lines 44-57),

culling attributes for the individual from the second database based on their identity (Col. 10, lines 6-12),

selecting an advertising message based on the culled attributes (Col. 14, lines 55-64),

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transmitting the selected message to the consumer over the Internet (Col. 14, lines 55-64),

transferring the information to the consumer over the Internet (Col. 14, lines 44-54),

transmitting the vendor link over the Internet (Col. 14, lines 55-64), and
connecting the consumer to the vendor when the consumer activates the vendor link (Col. 14, lines 55-64);

Dedrick does not teach the following limitations:

“Internet” and “web site”

de Hond teaches web sites using hyper text markup language documents over the Internet (Col. 2, lines 38-62). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add Internet and web cite capability to **Dedrick's** inventions for processing information in hypertext markup language as taught by **de Hond's** invention in order to provide linkage to documents on the same or other computer systems.

4. Claims 24,27,30,32,34,36,38,40,42,44 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dedrick** in view of **de Hond** and further in view of **Murphy** (US 5,305,195).

As to Claims 24,27, **Dedrick** teach the limitations as rejected in Claim 23 and the following:

Dedrick does not teach the following limitation:

“wherein the limited access information comprises student grades”

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Murphy teaches advertisers sponsoring students use of terminals for grades reporting (Col. 4, lines 23-31). This teaching suggests that grades can be added to **Dedrick's** clearinghouse database so that advertisers can provide advertisements to students who want to see their grades. Therefore, having the cited art at the time the invention was used, it would have been obvious to one of ordinary skill in the art to add grade reporting to **Dedrick's** clearinghouse database to sponsor terminal use as taught by **Murphy's** invention in order to provide student users with advertisements and commercial offerings when seeking grade reports.

Response to Arguments

5. Applicant's arguments filed 7/15/04 have been fully considered but they are not persuasive because of the following:

(a) The cited **Roth** (US 6,285,987) reference is not prior art but it identified the **Murphy** reference which teaches the students grades limitation that was objected to in the 4/13/04 Office Action. Therefore, the objections to claims 24 and 27 are withdrawn. This instant office action is non-final which includes the rejection of these and other similar claims.

(b) The **Dedrick** references do not teach attributes that are known. Examiner respectfully disagrees because **Dedrick** teaches that advertisers use information that was obtained by monitoring users actions and inactions to information (Col. 4, lines 5-10). This is the same process taught in the disclosure at Page 13, lines 5-8 and cited by Applicants.

In the **Dedrick** references, the publishers and advertisers do not know the identity of the subscribers. Examiner respectfully disagrees. This is because the argument suggests the validating of a user's identity in the second database which is not claimed. The claims only

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recite determining the identity in the second database. As taught by **Dedrick**, the metering database determines the identity of a user using a user identification (Col. 9, lines 44-57). Thus advertisers are able to transmit information to specific users and not just general users as argued (Col. 10, lines 30-38). In addition, **Dedrick** teaches that a user's real identification information can be transmitted to advertisers under certain circumstances (Col. 7, lines 35-46). Also, **Dedrick** suggests that personal profile database 27, where user's identity are validated, is an extension of the metering database 14 because they communicate transfer of user profile information (Col. 7, lines 23-35). Therefore, it would be obvious to combine the two databases to achieve validation of users in the second database.

The **Dedrick** references do not teach customizing because there is no targeting of users. Examiner respectfully disagrees because **Dedrick** teaches targeting of specific users (Col. 10, lines 40-47, Col. 12, lines 34-43).

Examiner respectfully believes that the 35 USC 103 rejections of the claims were proper based upon the responses above.

(c) Examiner also respectfully invites Applicants to contact Examiner to discuss possible amendments for overcoming the prior art of record.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Weinblatt (US 5,515,270) teach correlating consumer purchasing to advertisements.

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7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231
or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

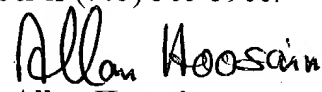
(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


Allan Hoosain
Primary Examiner
10/22/04